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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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TM02/0118  
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EXAMINER

RETTA, Y

ART UNIT

PAPER NUMBER

2102

DATE MAILED: 01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/613,153

Applicant(s)

Filed

Examiner

Yehd ga Retta

Group Art Unit  
2162

☒ Responsive to communication(s) filed on Jul 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-50 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☒ Claim(s) 1-20 is/are allowed.

☒ Claim(s) 21-50 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Reissue Applications***

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 22, 32 and 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Claims 22, 32, 42, recite the metric selected from the group comprising a price/ratio and a price/earning ratio, for each stock. The specification as originally filed does not clearly support the selection comprising of a price/sales ratio and a price/earning ratio for each stock. Pages 3-5 describes the selecting critrea consisting of the buyback ratio and either the price/sales ratio or price earnings ratio, however the selecting critrea consisting of the buyback ratio and either the price/sales ratio or price earnings ratio is not the same as and does not provide clear support for selection comprising of price/sales ratio and a price/earning ratio for each stock. As a result, claims 22, 32 and 42 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that applicant had possession of the claimed invention.

7. Claims 23, 33 and 43 are rejected since they depend on rejected claims.

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*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 21-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Shaughnessy U.S. Patent No. 5978778, in view of Hulbert "Putting their money where their mouths are".

10. Regarding claims 21, 30, 31, 40, 41, 50, O'Shaughnessy teaches selection of stocks from a database of stock information; identifying stocks from the specified selection meeting certain criteria; and generating a report ranking a set of the identified stocks based on metric associated with performance of the corresponding company (see col. 11 lines 20-67); generating a report ranking a set of identified stocks based on metric associated with performance of the corresponding company (see col. 12 lines 37-67). O'Shaughnessy does not specifically teach the selection criteria having buyback ratio, wherein the buyback ratio corresponds to a percentage of shares of issued stock repurchased from the public during a specific period. Hulbert teaches

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generating report ranking a set of identified stocks with buyback ratio based on a metric associated with buyback ratio corresponding to a percentage of shares of issued stock repurchased from the public during a specified period (see page 1 and 2). Hulbert teaches the “buyback best buys” list identifies companies who repurchased their stock and ranking them based on a metric associated with buyback ratio (see page 2 “the buyback best buys” list). It would have been obvious to one of ordinary skill in the art at the time of invention to combine O’SHAUGHNESSY selection of stock based on certain criteria and Hulbert identifying companies repurchasing their stock, in order to invest wisely as taught by Hulbert (see page 1 and 2).

11. Regarding claims 22, 32, and 42, O’ Shaughnessy teaches metric selected from the group comprising a price/sales ratio and a price/earning ratio, for each stock (see col. 12 lines 1-68).

12. Regarding claims 23, 33, and 43, O’ Shaughnessy teaches the database including a market cap value (see col. 12 lines 1-68).

13. Regarding claims 24, 25, 34, 35, 44 and 45, O’SHAUGHNESSY teaches identifying companies from database such as Standard and Poor index, (see col. 11 line 63-67).

14. Claims 26-29, 36-39, and 46-49 are rejected as stated above in claim 1.

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*Allowable Subject Matter*

15. Claims 1-20 are allowed.

*Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A buyback binge, Kaye, Steven D., U.S. News & World Report, v122, n6, p69, Feb 17, 1997.

What to do with profits, Special to the Washington Post, James K. Glassman,  
<http://www.recordernews.com/1997/0920/business/wehat/wehat.htm>.

The option to repurchase stock; Financial Management; Tampa; Winter 1996; David L Ikenberry; Theo Vermaelen;

<http://proquest.umi.com/pqdweb?TS=...=1&Did=000000011355795&Mtd=1&Fm>.

Actual Share Reacquisitions in Open-Market Repurchase Programs, Clifford P. Stephens and Michael S. Weisbach.

Market underreaction to open market share repurchases, David Ikenberry, Josef Lakonishok, Theo Vermaelen.

Solving antidilution problems, Glover, Stephen I., Business Lawyer, 51, n4, 1241-1302, August, 1996.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner  
Yehdega Retta  
Art Unit 2162  
January 15, 2001

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2160



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**Requirement for Information Under 37 C.F.R. § 1.105**

Attachment to paper No. 2

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. In response to this requirement, please provide a list of citations to electronically searchable databases or other indexed collections containing publications that document the knowledge within the disclosed art of "The BuyBack Letter", published by the Applicant, as stated in the article "A buyback Binge" by Kaye, issued Feb. 17, 1997.
3. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.
4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.
5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period

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for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is THREE months.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

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Examiner  
Yehdega Retta  
Art Unit 2162  
January 15, 2001

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100